

RESPONSE TO OFFICE ACTION MAILED SEPTEMBER 5, 2003
Patent 09/968,905

None of the remarks in the response herein to the Examiner's assertions or acceptance of his admissions are intended to surrender any equivalents whatsoever under the holding of *Festo Corp. v. Shoketsu Kinzouku Kogyo Kabushinik Co.* 535 U.S. 722 (2002).

Section 102 Rejection

The Examiner rejects claims 1-7, 10-11 and 25-26 under 35 U.S.C. 102(b) as being anticipated by "User's Guide, Borland Paradox for Windows;" Borland International, Inc.; v5.0; 1994 (hereinafter "Paradox").

The Applicant traverses all of the Examiner's assertions and responds as follows. Applicant specifically responds to selected assertions made by the Examiner, but still intends that all the assertions are traversed.

First Section 102 Response

First, the Examiner is reminded that make a *prima case* of anticipation, the identical invention must shown in as complete detail in a single prior art reference as is contained in the anticipated claim. *Richardson v. Suzuki Motor Co.*, 808 F.2d 1226, 1236 (Fed. Cir. 1989).

The Examiner asserts that Paradox teaches "obtaining information from other organizations (i.e., a plurality of respositories) (pg. 268-275), through the functionality of identifying information output by filename from another source and its format." The Examiner by his own words, did not assert that Paradox

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teaches any reference to unclaimed property information as is recited by the claimed invention.

Claim 1 recites in part, a method for acquiring unclaimed property information, comprising: obtaining periodically a plurality of unclaimed property information from a plurality of unclaimed property repositories, wherein the plurality of unclaimed property information is maintained in a plurality of formats by the plurality of unclaimed property repositories.

Nowhere does Paradox teach the identical invention including at least the claim element of periodically obtaining unclaimed property information from a plurality of unclaimed property repositories. Thus, Paradox cannot anticipate the claimed invention under the holding of *Richardson*. Therefore, the Examiner has not made out a *prima facie* case of anticipation under 35 USC 102(b) and the Applicant need not respond any further. However, so this response will not be deemed unresponsive by the Examiner, the Applicant responds further as follows.

Second, the Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Nowhere does Paradox teach either expressly or inherently, at least the claim element of periodically obtaining unclaimed property information from a

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plurality of unclaimed property repositories. Thus, Paradox cannot anticipate the claimed invention under the holding of *Verdegall Bros.* either.

Third, the Examiner is reminded that, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). The mere fact that certain thing may result from a give set of circumstances is not sufficient to prove inherency. *In re Robinson*, 169 F.3d 743, 745 (Fed. Cir. 1999). In relying on a theory of inherency, must provide a basis in fact and/or technical reasoning to reasonably support the determination that a characteristic necessarily flows from the teachings of the applied prior art. *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

It is clear that Paradox does not expressly teach the claim element of periodically obtaining unclaimed property information from a plurality of unclaimed property repositories. Thus, the Examiner, as the Applicant understands his assertions appears to be asserting Paradox, as a database tool, could somehow *inherently* be programmed to take the affirmative step of specifically periodically obtaining unclaimed property information from a plurality of unclaimed property repositories as is recited by the claimed invention and obtain the same result as the claimed method.

However, Paradox was developed as a general database tool and nowhere does Paradox inherently teach that it was developed specifically for,

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has, or even could or have the capabilities of, taking the affirmative step of periodically obtaining unclaimed property information from a plurality of unclaimed property repositories. Thus, Paradox cannot anticipate the claimed invention under the holdings of *In re Rijckaert*, *In re Robinson*, or *Ex Parte Levy* either.

Fourth, Paradox, in the sections cited by the Examiner, starts its teaching by assuming that data has already been obtained, teaching by its explicit recited language "If you choose to import data from any of the supported spreadsheet formats..." and "The spreadsheet that contains the data you want to import." (pg. 269). Thus, the Examiner's initial assertions for anticipation appear to faulty with respect to anticipation and this explicit language.

Fifth, assuming, Paradox did have the functionality to execute the method step of periodically obtaining unclaimed property information from a plurality of unclaimed property repositories, which it apparently does not, Paradox teaches explicit limitations not present in the claimed invention for transforming information and thus does not teach the identical invention recited by the claims.

For example, the Examiner asserts that Paradox teaches "transforming the plurality of information maintained in a plurality of formats into a unified database format, thereby creating transformed information (pg. 268-275)."

However, Paradox, instead teaches once data is obtained, the data can be imported into a database only in three formats including, supported

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spreadsheet formats (pg. 296), delimited text file formats (pg. 271) and fixed length text file formats. (pg. 272). The claimed invention does not have such limitations.

In contrast, the Application teaches the unclaimed property information is maintained in multiple formats by the multiple unclaimed property repositories including: (1) CD-ROMS; (2) computer tapes; (3) other computer readable formats; and (4) a variety of paper or other types of documents including microfiche. Since the unclaimed property information is maintained in multiple formats, some types of information may require initial manual processing by data entry operators (e.g., paper and microfiche). Portions of this manual processing may also be automated by electronically scanning or otherwise processing unclaimed property information from paper and microfiche and storing it in desired electronic formats. (Application, page 12, lines 15-23).

Thus, Paradox, even if it could be programmed to execute the steps of the claimed method, which it apparently can not, it does not teach all of the features of the claimed invention and teaches explicit limitations for processing data not present in the claimed inventions. Therefore, Paradox based its explicit teachings cited by the Examiner cannot anticipate the claimed invention.

Finally, the Applicant is claiming various methods and systems for obtaining and processing unclaimed property information that include various claim limitations that include database functionality. However, the Applicant is

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not trying to claim a general database tool such as that described by Paradox as the Examiner is suggesting.

Based on these remarks, Paradox does not teach each and every element as set forth in the claimed invention either expressly or inherently. Thus, Paradox cannot anticipate the claimed invention. Therefore, the Applicant now requests the Examiner immediately withdraw the §102(b) rejections with respect to Claims 1-7, 10-11 and 25-26. Since these claims are not anticipated they should be immediately allowable in their present form.

Section 103 Rejection

The Examiner asserts Claims 8-9 and 12-24 are rejected under U.S.C. §103(a) as being unpatentable over Paradox. The Applicant traverses all of the Examiner's assertions, accepts all the Examiner's admissions, and responds as follows. Applicant specifically responds to selected assertions made by the Examiner, but still intends that all the assertions are traversed.

Section 103 Response

All of the Section 102 arguments stated above with respect to comparing the claimed invention to Paradox are including herein by reference.

Claims 8-9 and 12-18

With respect to Claims 8-9 and 12-18 the Examiner admits "Paradox does not specifically disclose create a plurality of pass through database records; reading the database information to determine contact information relative to the

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database information; or using the contact information to provide notifications; electronically collecting appropriate information required by one or more service providers (e.g., unclaimed property repositories) to disburse unclaimed property; nor electronically collecting a fee." The Applicant accepts the Examiner's admissions with respect to these claims.

The Examiner then "takes Official Notice that it was old and well known in the art at the time the invention was made that links (linking addresses) could be used as data entries in a database to automatically link to and draw data from the referenced database for the purpose of efficiency/economy of database operations and database space utilization. The link data would be a data entry equivalent to any other, but utilizing a particular format for functional purposes. Additionally, Official Notice is taken that it was old and well known in the art at the time the invention was made that contact information may be obtained and stored by service providers in a database with other data for the purpose of communicating status and other pertinent information to the contacts and charging a fee for the service of communicating such data. An example is buyer information for buyers who buy products through on-line or on-site sales and pay electronically (e.g., by providing credit card information). This information is often used for payment processing, warranty validation, delivery notification, and/or communication processing for other purposes. Also, service providers typically charge fees for the services they perform. Therefore, it would have been obvious

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to one skilled in the art at the time the invention was made to modify the disclosure of Paradox to specifically create a plurality of pass-through database records, read the database information to determine contract information relative to the database information, use the contact information to provide notifications, electronically collecting appropriate information required by one or more services providers (e.g., unclaimed property repositories) to disburse unclaimed property, and electronically collecting a fee, as disclosed by old and well known art, for the motivation of acquiring unclaimed property information and automatically requesting disbursement of unclaimed property." The Applicant traverses the Examiner's taking of Office Notice.

The Examiner is reminded that to establish *prima facie* obviousness of a claimed invention in the first place, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). In addition, the Examiner is reminded that all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

As was discussed above, Paradox does not teach or suggest all of the claim limitations, because Paradox as a database tool, does *not teach or suggest, or even mention* at least the method step of periodically obtaining unclaimed property information from a plurality of unclaimed property

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repositories or the *claim words* unclaimed property information at all. Thus,

Claim 1 cannot be obvious in view of Paradox.

Claims 8-9 dependent claims, depending on independent Claim 1. These claims add additional limitations not present in Claim 1, but include the limitations of Claim 1 with respect to the method step and references to unclaimed property information. The Examiner is reminded that if an independent claim is non-obvious under 35 USC 103, then any claim depending there from is non-obvious *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988).

The Applicant has clearly pointed out why Independent Claim 1 is not obvious (or anticipated) Claims 8 and 9 are not obvious. Thus, the Examiner has failed to establish *prima facie* obviousness based on the holding of *In re Royka*, *In re Wilson* and *In re Fine*. Applicant need not respond any further. However, for the sake of completeness, the Applicant now responds to the Examiner's specific assertions.

Applicant now points out errors in the Examiner's Official Notice facts. Since Paradox was developed as a general database tool, it was not developed and does not include the recited methods for specifically periodically obtaining and processing unclaimed property information as is recited by the claimed invention. In fact, Paradox does not explicitly mention or implicitly imply that such a database tool could ever be programmed to execute the claimed

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invention or be programmed to obtain or specifically process unclaimed property Information.

The Examiner is reminded that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

Since Paradox was developed as a general database tool for use for many different purposes, modifying Paradox to specifically include obtaining and processing unclaimed property information would render Paradox unsatisfactory for one of its intended purposes of being a general database tool and not a specifically focused database tool. In addition, because Borland was in the business of selling general purpose tools, including database tools, it is highly unlikely such a modification would have been allowed or even considered by Borland.

Thus, there can be no motivation to modify Paradox for "acquiring unclaimed property information and automatically requesting disbursement of unclaimed property" as the Examiner suggests based on the holding of *In re Gordon*.

Since the Applicant has pointed out errors in the Examiner's Official Notice assertion, the Examiner must now provide documentary evidence to support the

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Official Notice in the next Office Action if the rejection is to be maintained under the holding of *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

Applicant specifically requests the Examiner provide documentary evidence as to why a general database tool like Paradox would be modified to specifically include obtaining and processing unclaimed property information with the specific limitations and features as recited by the claimed invention.

The Applicant has clearly pointed out why Claims 8 and 9's corresponding independent Claim 1 is not obvious these dependent claims are not obvious under the holding of *In re Fine*.

Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 8-9. Since these claims are not obvious they should be immediately allowable in their present form

Claims 19-20

All of the previous anticipation and obviousness arguments made by the Applicant are incorporate herein by reference for Claims 19-20. The Applicant traverses all of the Examiner's assertions with respect to Claims 19-20.

Applicant was not provided with pages 508-525 of Paradox as cited by the Examiner in the Office Action papers mailed to the Applicant. However, Applicant responds to the Examiner's assertions anyway.

Paradox is a general database tool and Paradox simply does not teach, suggest or even mention any of the steps of the method or claimed limitations

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recited by Claims 19-20 including at least allowing an identified owner of unclaimed property to request unclaimed property.

The Examiner's asserts "Official Notice is taken that delivery of the property or product when forms/applications/purchase agreements are (electronically or manually) completed was old and well known in the art at the time the invention was made and encompasses the feature of automatically requesting disbursement to the identified owner at that time. On-line service providers fulfill their agreements when their requirements are met (e.g., payment is provided). And, the forms stored in a database can be used to automatically draw pertinent data from the database when the forms are used, based on query routines stored and used by the database user. Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify the disclosure of Paradox to specifically disclose disbursing or delivering the property or product (e.g., unclaimed property) when forms/applications/purchase agreements are completed, as disclosed by old and well known art, the for the motivation of automatically requesting disbursement of unclaimed property." The Applicant traverses the Examiner's taking of Official Notice.

Applicant now points out errors in the Examiner's Official Notice facts. Since Paradox was developed as a general database tool, it was not developed and does not include the recited methods for specifically periodically obtaining and processing unclaimed property information as is recited by the claimed

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invention. In fact, Paradox does not explicitly mention or implicitly imply that such a database tool could ever be programmed to execute the claimed invention or be programmed to obtain or specifically process unclaimed property information.

Since Paradox was developed as a general database tool for use for many different purposes, modifying Paradox to specifically include obtaining and processing unclaimed property information would render Paradox unsatisfactory for one of its intended purposes of being a general database tool and not a specifically focused database tool. Thus, there can be no motivation to modify Paradox for "automatically requesting disbursement of unclaimed property" as the Examiner suggests based on the holding of *In re Gordon*.

Since the Applicant has pointed out errors in the Examiner's Office Notice assertion, the Examiner must now provide documentary evidence to support the Official Notice in the next Office Action if the rejection is to be maintained under the holding of *In re Zurko*.

Applicant specifically requests the Examiner provide documentary evidence as to why a general database tool like Paradox would be modified to specifically include automatically requesting disbursement of unclaimed property with the specific limitations and features as recited by the claimed invention.

For the reasons stated above, Claims 19-20 are not obvious. Therefore, the Applicant now requests the Examiner immediately withdraw the §103

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rejections with respect to Claims 19-20. Since these claims are not obvious they should be immediately allowable in their present form.

Claims 21-24

All of the previous anticipation and obviousness arguments made by the Applicant are incorporate herein by reference. The Applicant traverses all of the Examiner's assertions with respect to Claims 21-24.

The Examiner admits "Paradox does not specifically disclose the fee is electronically collected automatically for a credit card, or electronically deducted from a checking or savings account." The Applicant accepts the Examiner's admissions.

The Examiner asserts "Official Notice is taken that it was old and well known in the art at the time the invention was made that fees could be electronically collected automatically for a credit card, debit card, or electronically deducted from a checking or savings account by on-line service providers. This facilitates rapid transaction verification and completion for the on-line service providers. Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify the disclosure of Paradox specifically electronically collect the fee automatically for a credit card, debit card or electronically deducted from a checking or savings account, as disclosed by old and well known art, for the motivation of automatically requesting disbursement

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of unclaimed property." The Applicant traverses the Examiner's taking of Official Notice.

Applicant now points out errors in the Examiner's Official Notice facts. Since Paradox was developed as a general database tool, it was not developed and does not include the recited methods for specifically periodically obtaining and processing unclaimed property information as is recited by the claimed invention. In fact, Paradox does not explicitly mention or implicitly imply that such a database tool could ever be programmed to execute the claimed invention or be programmed to obtain or specifically process unclaimed property information.

Since Paradox was developed as a general database tool for use for many different purposes, modifying Paradox to specifically include obtaining and processing unclaimed property information would render Paradox unsatisfactory for one of its intended purposes of being a general database tool and not a specifically focused database tool. Thus, there can be no motivation to modify Paradox for "automatically requesting disbursement of unclaimed property" as the Examiner suggests based on the holding of *In re Gordon*.

Since the Applicant has pointed out errors in the Examiner's Office Notice assertion, the Examiner must now provide documentary evidence to support the Official Notice in the next Office Action if the rejection is to be maintained under the holding of *In re Zurko*.

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Applicant specifically requests the Examiner provide documentary evidence as to why a general database tool like Paradox would be modified to specifically include automatically requesting disbursement of unclaimed property with the specific limitations and features as recited by the claimed invention.

Claims 21-24 are dependent claims. Each of these claims adds additional limitations to the invention not taught or suggested by Paradox. Since the Applicant has clearly pointed out why their corresponding independent claim is not obvious these dependent claims are not obvious under the holding of *In re Fine*.

Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 21-24. Since these claims are not obvious they should be immediately allowable in their present form.

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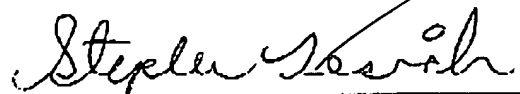
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CONCLUSION

The prior art made of record in the Office Action but not relied upon by the Examiner is no more pertinent to Applicant's invention than the cited references for the reasons given above. The Applicant therefore submits that all of the claims in their present form are immediately allowable and requests the Examiner withdraw the §102 and §103 rejections of claims 1-26 and pass all of the claims to allowance.

Respectfully submitted.

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